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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,102	04/13/2004	Jan Batzer	104035.277308	6148

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GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER
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HUYNH, CARLIC K

ART UNIT	PAPER NUMBER
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1617

NOTIFICATION DATE	DELIVERY MODE
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10/23/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/824,102	BATZER ET AL.	
	Examiner	Art Unit	
	Carlic K. Huynh	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 12-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :13 April 2004, 30 August 2004 and 27 June 2005.

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-55 are pending in the application, with claims 46-55 having been withdrawn from consideration, in response to the restriction requirement submitted on August 13, 2007. Accordingly, claims 1-45 are being examined on the merits herein.

### ***Election/Restrictions***

2. Applicant's election with traverse of Group I, namely claims 1-45, in the reply filed on September 13, 2007 is acknowledged. The traversal is on the ground(s) that the product claims of Groups I, which are directed to a cosmetic or dermatological preparation comprising an anti-oxidant and 8-hexadecene-1,16-dicarboxylic acid and the method claims of Group II, which are directed to a method of treating unwanted pigmentation comprising administering the product of Group I, overlap and thus there would not be a serious search burden to the Examiner.

Applicants' arguments were not found persuasive. The arguments were not found persuasive because many products can be used with the process of Group II and thus the search for the products of Group I will not necessarily yield the process of Group II. Furthermore, if the product claims of Group I are found allowable, then the process claims of Group II will be rejoined. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104, as per *In re Ochiai*.

Claims 46-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made with traverse in the reply filed on September 13, 2007.

3. Applicants' election with traverse of: (1) folic acid as the species of an antioxidant, in the reply filed on September 13, 2007 is acknowledged. The traversal is on the ground(s) that all of the antioxidants of the composition includes 8-hexadecene-1,16-dicarboxylic acid and a search of 8-hexadecene-1,16-dicarboxylic acid would yield any antioxidant, including folic acid. Thus there would be no search burden on the Examiner.

Applicants' arguments were not found persuasive. The Examiner maintains and argues that there is a search burden for antioxidants because each antioxidant is structurally distinct from one another. For example, folic acid is structurally different from lipoic acid, carnosine, bioquinone, and 3-[4-hydroxyphenylsulfate ester]. Thus there would be a search burden for the Examiner to search for any antioxidant.

Claims 3, 4, and 12-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made traverse in the reply filed on September 13, 2007.

Accordingly, claims 1, 2, and 5-11 are examined on the merits herein.

The election/restriction requirement is deemed proper and is made FINAL.

Claims 1, 2, and 5-11 are directed to a cosmetic or dermatological preparation and thus intended use is not given any patentable weight.

***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Germany on October 13, 2001 and December 22, 2001. It is noted, however, that applicant has not filed a certified copy of the 101 50 731.3, 101 50 732.1, 101 50 734.8, 101 50 735.6, 101 50 742.9, and 101 63 786.1 applications as required by 35 U.S.C. 119(b).

***Information Disclosure Statement***

The Information Disclosure Statements submitted on April 13, 2004, August 30, 2004, and June 27, 2005 are acknowledged.

***Specification***

5. The use of the trademarks Parsol®, Eusolex®, Tinosorb®, Mexoryl®, and Uvinul® have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1617

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding et al. (US 5,705,144) in view of Schönrock et al. (US 6,296,857).

Harding et al. teach a composition to lighten the skin comprising a dioic acid having the general structure of



Where  $a$  is from 4 to 20 and  $b$  is from 8 to 40 (abstract; and column 2, lines 44-47). It is noted that 8-hexadecene-1,16-dicarboxylic acid fits into the dioic acid of Harding et al. where  $a$  is 16 and  $b$  is 30. Thus, the limitation of 8-hexadecene-1,16-dicarboxylic acid is met. The dioic acid of Harding et al. is present from 0.1 to 30% by weight of the composition (column 3, line 25).

Harding et al. also teaches that the dioic acid composition further contains cosmetic adjuncts such as antioxidants (column 11, line 21). The cosmetic adjunct can form the balance of the composition (column 11, lines 29-30).

Harding et al. do not teach folic acid.

Schönrock et al. teach a method for cosmetically lightening large areas of skin comprising the antioxidant folic acid, which may and may not include vitamin E (column 1, line 20; column 12, lines 49-50 and 55; and column 13, lines 13 and 19). The antioxidant is present from 0.001 to 30% by weight of the composition (column 13, lines 31-32).

Accordingly, absent the showing of unexpected results, it would have been obvious to a person of skill in the art at the time of the invention to employ the composition of Harding et al. to contain folic acid because the compounds of Schönrock et al. are compositions

Art Unit: 1617

containing folic acid and according to Schönrock et al., a composition comprising folic acid can lighten large areas of skin.

The motivation to combine the compounds of Harding et al. to the compounds of Schönrock et al. is that the compounds of Schönrock et al. are compositions comprising folic acid and that such compositions lighten large areas of skin.

It is noted that “It is obvious to combine individual compositions taught to have the same utility to form a new composition for the very same purpose” and “It is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose”. *In re Kerkhoven*, 626 F.2d 846, 205 U.S.P.Q. 1069 (C.C.P.A. 1980).

Regarding weight of the antioxidant as recited in instant claims 5-8, Schönrock et al. teach the antioxidant is present from 0.001 to 30% by weight of the composition, which closely meets the percentage weight of the antioxidant set forth in instant claims 5-8 (column 13, lines 31-32). It is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of antioxidant provided in a composition, according to the guidance set forth in Schönrock et al., to provide a composition having desired antioxidant content. It is noted that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 223, 235 (CCPA 1955).

Regarding weight of 8-hexadecene-1,16-dicarboxylic acid as recited in instant claims 9-11, Harding et al. teach the dioic acid present from 0.1 to 30% by weight of the composition, which closely meets the percentage weight of the 8-hexadecene-1,16-dicarboxylic acid set forth



Art Unit: 1617

in instant claims 9-11 (column 3, line 25). It is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of 8-hexadecene-1,16-dicarboxylic acid provided in a composition, according to the guidance set forth in Harding et al., to provide a composition having desired 8-hexadecene-1,16-dicarboxylic acid content. It is noted that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 223, 235 (CCPA 1955).

### ***Double Patenting***

#### **Obviousness-Type**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1617

7. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of copending Application Doring et al. (11/087,395) and claims 1 and 5 of copending Application Schulz (11/547,104).

Claims 1 and 13 of Doring et al. and claims 1 and 5 of Schulz are directed to a cosmetic preparation comprising folic acid and 8-hexadecene-1,16-dicarboxylic acid among other components.

The instant claims are directed to a cosmetic or dermatological preparation comprising folic acid and 8-hexadecene-1,16-dicarboxylic acid.

Since the claims of the instant application employs the open language of “comprising”, the claims of Doring et al. and Schulz would be obvious over the instant claims.

This is a provisional double patenting rejection since the conflicting claims have not been patented.

8. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11 of copending Application Goppel et al. (10/871,819) and claims 51 and 67 of copending Application Goppel et al. (10/871,861) in view of Schönrock et al. (US 6,296,857).

Claims 1 and 11 of Goppel et al. and claims 51 and 67 of Goppel et al. are directed to a light protective cosmetic composition comprising 8-hexadecene-1,16-dicarboxylic acid and alpha-lipoic acid among other components.

The instant claims are directed to a cosmetic or dermatological preparation comprising folic acid and 8-hexadecene-1,16-dicarboxylic acid.

Since the claims of the instant application employs the open language of “comprising”, the claims of Doring et al. and Schulz would be obvious over the instant claims.

Schönrock et al. teach that lipoic acid and its derivatives as well as folic acid are antioxidants (column 12, lines 55 and 62; and column 13, line 14). Thus it would be obvious that lipoic acid and folic acid are antioxidants.

This is a provisional double patenting rejection since the conflicting claims have not been patented.

9. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 18, and 20 of copending Application Kruse et al. (11/157,946) in view of Schönrock et al. (US 6,296,857).

Claims 1, 18, and 20 of Kruse et al. are directed to a self-adhesive polymer matrix comprising vitamin C and 8-hexadecene-1,16-dicarboxylic acid among other components.

The instant claims are directed to a cosmetic or dermatological preparation comprising folic acid and 8-hexadecene-1,16-dicarboxylic acid.

Since the claims of the instant application employs the open language of “comprising”, the claims of Doring et al. and Schulz would be obvious over the instant claims.

Schönrock et al. teach that vitamin C and folic acid are antioxidants (column 12, line 55; and column 13, lines 14 and 16). Thus it would be obvious that vitamin C and folic acid are antioxidants.

This is a provisional double patenting rejection since the conflicting claims have not been patented.

***Conclusion***


10. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlic K. Huynh whose telephone number is 571-272-5574. The examiner can normally be reached on Monday to Friday, 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ckh

  
CHENG WANG  
PATENT EXAMINER